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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,768	12/27/2001	Marco Johannes Hubertus Peters	Q67918	9801

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EXAMINER

QUINONES, ISMAEL C

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 08/03/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,768

Applicant(s)

PETERS, MARCO JOHANNES
HUBERTUS

Examiner

Ismael Quiñones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 3-8** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitations "said access subnetwork" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitations "said access subnetwork" in line 17. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-8 and 10** are rejected under 35 U.S.C. 102(e) as being anticipated by Rai et al. (U.S Pat. No. 6,393,482).

Regarding **claim 1**, Rai et al. disclose a method to provide service to a user in a telecommunications network (*col. 2, lines 34-38; col. 5, lines 1-8*), wherein said method includes the step of requesting access by said user to said telecommunication network in order to provide thereby an access request (Wherein a end system or a subscriber registers with a service provider, requesting mobile services from a serving network; *col. 6, lines 55-59; col. 7, lines 7-15*), characterized in that, said method further includes the step of providing by a notifying service provider to said user a notification which includes a capability to accept a service of an offered service provider different from said notifying service provider (A subscriber or end system that request mobile services in a foreign network, wherein the foreign network establishes communications with the subscriber's home network (wireless home service provider) in order to provide the subscriber with those services of the home service provider registered while its serving network is the foreign network; *col. 7, lines 7-15; col. 8, line 53 thru col. 9, line 50; col. 15, lines 31-61; col. 16, lines 29-43*).

Regarding **claim 2**, Rai et al. disclose a service provider to provide a service to a user in a telecommunication network (*col. 2, lines 34-38; col. 5, lines 1-8*), characterized in that said service provider includes a notifier to provide a notification to said user (Wherein the end system or wireless subscriber registers for service on a serving network, and a foreign agent in serving network base station notifies the end system/subscriber of a point of attachment; *col. 7, lines 58-61; col. 15, lines 31-34*), said notification including a

capability for said user to accept a service of an offered second service provider different from said service provider (A subscriber or end system that request mobile services in a foreign network, wherein the foreign network establishes communications with the subscriber's home network (wireless home service provider) in order to provide the subscriber with those services of the home service provider registered while its serving network is the foreign network; *col. 7, lines 7-15; col. 8, line 53 thru col. 9, line 50; col. 15, lines 31-61; col. 16, lines 29-43*).

Regarding **claim 3**, and as applied to claim 2, Rai et al. discloses the aforementioned service provider, characterized in that said service provider is associated to an access subnetwork (Wherein both the foreign network and the home networks comprise 3-sector base stations, such that an air link between each access point corresponding a sector of the base station and the end system or subscriber forms a wireless sub-network, therefore associating the sub-network with the serving network; *col. 10, lines 36-55; Fig. 4*) whereby a virtual environment is identified with said service provider and said access subnetwork (A virtual environment such as a virtual home environment which enables access to the services of a home service provider everywhere within the coverage of the system; *col. 7, lines 7-15; col. 8, line 53 thru col. 9, line 50; col. 15, lines 31-61; col. 16, lines 29-43*).

Regarding **claim 4**, and as applied to claim 3, Rai et al. discloses the aforementioned service provider, characterized in that said service provider is also constituted by said offered service provider (Wherein the service provider associated with

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the foreign service provider offers its own services to the end system or subscriber for optimizing routing based on the closest inter-working function; *col. 47, lines 20-56*).

Regarding **claim 5**, and as applied to claim 3, Rai et al. discloses the aforementioned service provider, characterized in that said offered service provider is constituted by a home service provider of said user (A home service provider offering services to the subscriber through the subscriber current or serving network; *col. 7, lines 7-15; col. 8, line 53 thru col. 9, line 50; col. 15, lines 31-61; col. 16, lines 29-43*).

Regarding **claim 6**, and as applied to claim 3, Rai et al. discloses the aforementioned service provider, characterized in that said service provider is also constituted by a home service provider of said user whereby said virtual environment is constituted by a virtual home environment of said user (A virtual environment such as a virtual home environment which enables access to the services of a home service provider everywhere within the coverage of the system; *col. 7, lines 7-15; col. 8, line 53 thru col. 9, line 50; col. 15, lines 31-61; col. 16, lines 29-43*).

Regarding **claim 7**, and as applied to claim 3, Rai et al. discloses the aforementioned service provider, characterized in that in the event when said service provider is not associated to an access subnetwork said service provider is also constituted by a home service provider of said user (Wherein the service provider or the foreign network is not physically or directly associated with access sub-network of the subscriber or end system home network; *Fig. 3*).

Regarding **claim 8**, and as applied to claim 7, Rai et al. discloses the aforementioned service provider, characterized in that said offered service provider is

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associated to said access subnetwork whereby a virtual environment is identified with said access subnetwork and said offered service provider (Wherein the offered service provider or home network (home service provider) is associated with the access subnetwork corresponding to that of the home network, wherein a virtual environment is created when provisioning services pertaining to the home network through the service provider or foreign network, ultimately conveyed to the end system or subscriber; *col. 7, lines 7-15; col. 8, line 53 thru col. 9, line 50; col. 10, lines 36-55; col. 15, lines 31-61; col. 16, lines 29-43; Fig. 3; Fig.4).*

Regarding **claim 10**, Rai et al. disclose a telecommunication network including at least one service provider to provide a service to a user in said telecommunication network (*col. 2, lines 34-38; col. 5, lines 1-8*), characterized in that said service provider includes a notifier to provide a notification to said user (*col. 7, lines 58-61; col. 15, lines 31-34*), said notification including a capability for said user to accept a service of an offered service provider different from said service provider (A subscriber or end system that request mobile services in a foreign network, wherein the foreign network establishes communications with the subscriber's home network (wireless home service provider) in order to provide the subscriber with those services of the home service provider registered while its serving network is the foreign network; *col. 7, lines 7-15; col. 8, line 53 thru col. 9, line 50; col. 15, lines 31-61; col. 16, lines 29-43).*

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. **Claim 1-8, and 10** are rejected under the judicially created doctrine of double patenting over **claims 1-9** of U. S. Patent No. 6,337,981. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-8, and 10 of the present application are a broader version of claims 1-9 of U. S. Patent No. 6,337,981.

Claim 1 of U. S. Patent No. 6,337,981, includes all of the limitations of claim 1 of the instant application as follows:

A method to provide service to a user in a telecommunications network, wherein said method includes the step of requesting access by said user to said telecommunication network in order to provide thereby an access request, characterized in that, said method further includes the step of providing by a notifying service provider to said user a notification which includes a capability to accept a service of an offered service provider different from said notifying service provider.

However, claim 1 of U. S. Patent No. 6,337,981 also includes the following limitations: that the telecommunications network is a “universal personal telecommunication network”, that requesting access is “requesting access by said user to said telecommunication network via a terminal (T) and via an access subnetwork (SUB-M2-H)”, that the step of providing by a notifying service provider to said user a notification which includes capability to accept a service of an offered service provider different from said notifying service provider is “providing by a notifying service provider (SP-H) to said user (U) via said access subnetwork (SUB-M2-H) a notification (N(SP-V)) which includes a capability to accept a service of an offered service provider (SP-V) and in the event that said notifying service provider is a home service provider of said user (U), said offered service provider is different from said notifying service provider”, and that “said service is a virtual visited environment (VVE) similar to a virtual home environment (VHE) but identified by said user (U) and said offered service provider (SP-V)”.

Nonetheless, the removal of said limitations from claim 1 of the present application, made claim 1 of the present application a broader version of claim 1 from U.

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S. Patent No. 6,337,981. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (*In re Karlson* (CCPA) 136 USPQ 184 (1963)), claim 1 of the present application is not patentably distinct from claim 1 of U. S. Patent No. 6,337,981.

Claim 2 of U. S. Patent No. 6,337,981, includes all of the limitations of claim 2 of the instant application as follows:

A service provider to provide service to a user in a telecommunication network, characterized in that said service provider includes a notifier to provide a notification to said user, said notification including a capability for said user to accept a service of an offered second service provider different from said service provider.

However, claim 2 of U. S. Patent No. 6,337,981 includes the following limitations: that the telecommunication network is “a universal personal telecommunication network receiving an access request from a user via terminal and via an access subnetwork of the telecommunication network”, that said service provider includes a notifier to provide a notification to said user is “said service provider (SP-H) includes a notifier (NOT) to provide a notification (N(SP-V)) to said user (U) via said access subnetwork (SUB-M2-H)”, that said notification including a capability for said user to accept a service of an offered service provider different from said service is “said notification (N(SP-V)) including a capability for said user to accept a service of an offered service provider (SP-V), and in the event that said service provider is a home service provider of said user (U), said offered service provider is different from said

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service provider” and that “said service being a virtual visited environment (VVE) similar to a virtual home environment (VHE) but identified by said user (U) and said offered service provider (SP-V)”.

Nonetheless, the removal of said limitations from claim 2 of the present application, made claim 2 of the present application a broader version of claim 2 from U. S. Patent No. 6,337,981. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (*In re Karlson* (CCPA) 136 USPQ 184 (1963)), claim 2 of the present application is not patentably distinct from claim 2 of U. S. Patent No. 6,337,981.

Claims 3-8 of U. S. Patent No. 6,337,981, includes all of the limitations of claims 3-8 of the instant application.

However, claims 3-8 of U. S. Patent No. 6,337,981 includes the limitations of claim 2 of U. S. Patent No. 6,337,981, upon which depend on: that the telecommunication network is “a universal personal telecommunication network receiving an access request from a user via terminal and via an access subnetwork of the telecommunication network”, that said service provider includes a notifier to provide a notification to said user is “said service provider (SP-H) includes a notifier (NOT) to provide a notification (N(SP-V)) to said user (U) via said access subnetwork (SUB-M2-H)”, that said notification including a capability for said user to accept a service of an offered service provider different from said service is “said notification (N(SP-V)) including a capability for said user to accept a service of an offered service provider (SP-

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V), and in the event that said service provider is a home service provider of said user (U), said offered service provider is different from said service provider” and that “said service being a virtual visited environment (VVE) similar to a virtual home environment (VHE) but identified by said user (U) and said offered service provider (SP-V)”.

Nonetheless, the removal of said limitations from claim 2 of the present application, made claims 3-8 of the present application a broader version of claims 3-8 from U. S. Patent No. 6,337,981. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (*In re Karlson* (CCPA) 136 USPQ 184 (1963)), claims 3-8 of the present application are not patentably distinct from claims 3-8 of U. S. Patent No. 6,337,981.

Claim 9 of U. S. Patent No. 6,337,981, includes all of the limitations of claim 10 of the instant application as follows:

A telecommunication network including at least one service provider to provide a service to a user in said telecommunication network, characterized in that said service provider includes a notifier to provide a notification to said user, said notification including a capability for said user to accept a service of an offered service provider different from said service provider.

However, claim 9 of U. S. Patent No. 6,337,981 includes the following limitations: that the telecommunication network is “a universal personal telecommunication network receiving an access request from a user via terminal and via

an access subnetwork of the telecommunication network”, that said service provider includes a notifier to provide a notification to said user is “said service provider (SP-H) includes a notifier (NOT) to provide a notification (N(SP-V)) to said user (U) via said access subnetwork (SUB-M2-H)”, that said notification including a capability for said user to accept a service of an offered service provider different from said service is “said notification (N(SP-V)) including a capability for said user to accept a service of an offered service provider (SP-V), and in the event that said service provider is a home service provider of said user (U), said offered service provider is different from said service provider” and that “said service being a virtual visited environment (VVE) similar to a virtual home environment (VHE) but identified by said user (U) and said offered service provider (SP-V)”.

Nonetheless, the removal of said limitations from claim 10 of the present application, made claim 10 of the present application a broader version of claim 9 from U. S. Patent No. 6,337,981. Therefore, since omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before (*In re Karlson* (CCPA) 136 USPQ 184 (1963)), claim 10 of the present application is not patentably distinct from claim 9 of U. S. Patent No. 6,337,981.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Liu (U.S. Pat. No. 5,825,759), Distributing Network Services and Resources in a Mobile Communication Network.
 - b. Clapton et al. (U.S. Pat. No. 6,556,823), Location Dependent Service for Mobile Telephones.
 - c. Leung (U.S. Pat. No. 6,195,705), Mobile IP Mobility Agent Standby Protocol.
 - d. Haumont et al. (U.S. Pat. No. 6,584,314), Location Management in a Mobile Telecommunication System.
 - e. Uskela (U.S. Pat. No. 6,721,886), Preventing Unauthorized use of Service.
 - f. Rahman et al. (U.S. Pat. No. 6,721,886), Network Based Tariff Acquisition System for Roaming Mobile Subscribers.
9. Any response to this Office Action should be **faxed to** (703) 872-9306 or **mailed to:**

Commissioner of Patents and Trademarks

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Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

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Sixth Floor (Receptionist)

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10. Any inquiry concerning this communication on earlier communications from the Examiner should be directed to Ismael Quiñones whose telephone number is (703) 305-8997. The Examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.


11. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379, and fax number is (703) 746-9818. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose number is (703) 305-4700 or call customer service at (703) 306-0377.

Ismael Quiñones

I.Q.

July 26, 2004


RAFAEL PEREZ-GUTIERREZ
PATENT EXAMINER
7/26/04